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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/462,845 01/13/00 ESTELL

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JEFFERY D FRAZIER  
GENENCOR INTERNATIONAL INC  
925 PAGE MILL ROAD  
PALO ALTO CA 94304-1013

HM22/0927

EXAMINER

PAK, Y

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

09/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/462,845

Applicant(s)

ESTELL, DAVID A.

Examiner

Yong Pak

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

### DETAILED ACTION

This application is a 371 of PCT/US98/14647.

Claims 1-15 are pending.

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7 and 9-15 (partially), drawn to a microorganism having a mutation or deletion of part or all of gene encoding SP1, a vector comprising said DNA and a method of producing SP1.

Group II, claim(s) 8 (partially), drawn to SP1.

Group III, claim(s) 1-7, and 9-15 (partially), drawn to a microorganism having a mutation or deletion of part or all of gene encoding SP2, a vector comprising said DNA and a method of producing SP1.

Group IV, claim(s) 8 (partially), drawn to SP2.

Group V, claim(s) 1-7, and 9-15 (partially), drawn to a microorganism having a mutation or deletion of part or all of gene encoding SP3, a vector comprising said DNA and a method of producing SP3.

Group VI, claim(s) 8 (partially), drawn to SP3.

Group VII, claim(s) 1-7, and 9-15 (partially), drawn to a microorganism having a mutation or deletion of part or all of gene encoding SP4, a vector comprising said DNA and a method of producing SP4.

Group VIII, claim(s) 8 (partially), drawn to SP4.

Group IX, claim(s) 1-7, and 9-15 (partially), drawn to a microorganism having a mutation or deletion of part or all of gene encoding SP5, a vector comprising said DNA and a method of producing SP5.

Group X, claim(s) 8 (partially), drawn to SP5.

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The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking I-X appears to be that they all relate to polypeptides with serine protease activity.

The DNA of Group I, III, V, VII and IX do not share a technical feature because the DNA encode proteins with different structures, characteristics and substrate specificities. The proteins of Group II, IV, VI, VIII and X do not share a technical feature because the proteins, have different structures, characteristics and substrate specificities.

The products of Groups (I and II), (III and IV), (V and VI), (VII and VIII) and (IX and X) do not share a technical feature because the DNA of Groups I, III, V, VII and IX encode a mutant polypeptide having inactivated protease activity and the proteins of Groups II, IV, VI, VIII and X are drawn to polypeptides with protease activity. Therefore, the technical feature linking (I and II), (III and IV), (V and VI), (VII and VIII) and (IX and X) is lacking.

Under 37 CFR 1.475 (d), a national stage may not relate to multiple products or multiple processes in one application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Drawings***

Drawings filed concurrently with the application have been approved by the Draftsman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is 703-746-3173.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

September 25, 2001



PONNATHAPUACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER